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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/599,450 | 05/23/2007 | Kazuhiro Yamamoto | 81922.0059 | 9138 |
| 26/021 7590 03/25/2009 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067 | | | | |
| EXAMINER | | | | |
| NEGRON, WANDA M | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2622 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,450

Applicant(s)

YAMAMOTO, KAZUHIRO

Examiner

WANDA M. NEGRON

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- **Group I, claim(s) 1-7 and 10-13**, drawn to a portable terminal comprising, *inter alia*, an acceleration sensor for measuring acceleration; and a control unit for performing a controlling function on the basis of said measurement.
- **Group II, claim(s) 8**, drawn to a portable terminal comprising, *inter alia*, a detector unit for detecting a number of times for handoff for a predetermined period of time; and a control unit for performing a controlling function on the basis of said detection.
- **Group III, claim(s) 9**, drawn to a portable terminal comprising, *inter alia*, a detector unit for detecting a number of times for position record for a predetermined period of time; and a control unit for performing a controlling function on the basis of said detection.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-III are drawn to a portable terminal comprising a photographic unit for photographing, and a control unit for controlling a photographic function. However, Group I is concerned with controlling said photographic function on the basis of a predetermined output produced by an acceleration sensor. Group II, on the other hand, is concerned with controlling said photographic function on the basis of a number of detections performed by a handoff detector unit, while Group III is concerned with controlling said photographic function on the basis of a number of detections performed by a position record detector unit. Therefore, the inventions lack the same special technical features under PCT Rule 13.

During a telephone conversation with applicant's representative, Mr. Troy M. Schmelzer (Registration No. 36,667), on March 19, 2009, a provisional election was made without traverse to prosecute the invention of Group III, claim 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 and 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites "a detector unit for detecting a number of times for position record for a predetermined period of time". The meaning of the term "a number of times for position record for a predetermined period of time" is unclear, and therefore, indefinite. For examination purposes, claim 9 will be interpreted as reciting "a detector unit for detecting a number of times positioning information is generated during a predetermined period of time" for the remainder of this Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al. (US Application Publication No. 2004/0046871), hereinafter referred to as Ichikawa, in view of Nakamura et al. (US Patent No. 5,548,370), hereinafter referred to as Nakamura.

Regarding **claim 9**, Ichikawa discloses a portable terminal 173 comprising: a photographic unit 107 for photographing an object; a detector unit for detecting

positioning information generated during a predetermined period of time (*i.e.*, a unit for determining that the portable terminal is located in a specific GPS location; see paragraphs [0067]-[0069]); and a control unit 117 for disabling photographing by the photographic unit 107 when the detector unit detects a particular positioning information after the photographic unit is set to a photographic mode (*i.e.*, disabling a photographing operation when the portable terminal is located in a specific GPS location; see paragraphs [0067]-[0069]).

Ichikawa, however, is silent on the subject of detecting if positioning information is generated a number of times during a predetermined period of time, and on the subject of disabling photographing by the photographic unit when the detector unit detects more positioning information generation than a predetermined number of times.

The concept of disabling a camera when a certain process is performed a predetermined number of times is well known in the art, as evidenced by Nakamura (see col. 8, lines 21-29, wherein photography is prohibited when vibration is detected a predetermined number of times).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to try to disable a photographic mode by determining if positioning information has been detected for more than a number of times during a predetermined amount of time since a person with ordinary skill has good reason to pursue the known options within his or her technical grasp if this leads to an anticipated result, *i.e.*, disabling a photographic mode when GPS information generation attempts exceeds a number of times.

Conclusion

The following prior art, made of record and not relied upon, is considered pertinent to applicant's disclosure.

- Hunter (US Application Publication No. 2002/0106202) discloses an apparatus for restricting the use of a portable camera within a predetermined area.
- Fujimiya (JP Application Publication No. 2003-198918) discloses a video camera wherein photography is prohibited on the basis of positional information.
- Miyake (US Patent No. 6,222,985) discloses a camera which records positional data of a GPS unit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WANDA M. NEGRON whose telephone number is (571)270-1129. The examiner can normally be reached on Mon-Fri 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 2622

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wanda M. Negrón/

Examiner, Art Unit 2622

March 22, 2009

/Sinh N Tran/

Supervisory Patent Examiner, Art Unit 2622